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OFFICE OF PETITIONS

In re Application of Randi L. Schindler : Decision on Petition
Application No. 09/152,992 :
Filing Date: September 14, 1998 :
Attorney Docket No. 05-10022 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 28, 2005, to revive the above-identified application. This is also a decision on the petition under 37 CFR 1.182 to change the name of the inventor.

The petition under 37 CFR 1.137(b) is **granted**.

The petition under 37 CFR 1.182 is **dismissed**.

The petition under 37 CFR 1.137(b)

Facts:

The application was filed on September 14, 1998.

The declaration filed with the application gives a power of attorney to Marshall Lerner, Marvin Kleinberg, and Michael Hurey. All three attorneys work for the law firm of Kleinberg & Lerner, LLP ("Kleinberg").

A non-final Office action was mailed November 12, 1998.

A reply to the November 12, 1998 Office action was filed on December 13, 1998.

A final Office action was mailed on March 15, 1999.

The inventor alleges she informed Kleinberg, specifically Michael Hurey, to file a reply to the final Office action. The specific date of this action is unknown.

A reply to the final Office action was not filed. Therefore, the application became abandoned as of midnight on June 15, 1999.

A Notice of Abandonment was mailed on November 9, 1999.

On an unspecified date, Hurey allegedly requested \$605 and allegedly advised the inventor an amendment would be filed per her request.

Petitioner alleges a petition under 37 CFR 1.137(b) and a check for the \$605 petition fee were mailed to the Office on March 31, 2000. A copy of the petition and check have been submitted. Office records do not indicate the receipt of the petition or the check. The March 31, 2000 petition does include a certificate of mailing signed by Helen Benninger, an employee of Kleinberg. However, a statement by Ms. Benninger, or a member of Kleinberg, has not been submitted.

During December of 2001, the inventor had the file transferred from Kleinberg to Lyon & Lyon, LLP ("Lyon"). A Revocation of Power of Attorney and Appointment of New Attorney was mailed to the Office on December 20, 2001. The Revocation is signed with the name, "Randi L. Black." However, the declaration filed with the application lists the inventor's name as Randi Lynn Schindler.

On January 16, 2002, Lyon sent a status inquiry to the Office.

On June 18, 2002, the inventor filed a Revocation of Power Attorney. The paper states that all previous powers of attorney are revoked. The paper states that all future correspondence should be addressed to the Law Offices of David H. Black. The paper is signed with the name "Randi L. Black." The instant petition is also accompanied by a Request for Continued Examination and amendment.

The inventor alleges that a status inquiry was mailed to the Office. The Office file does not indicate a status inquiry was ever received. A copy of the status inquiry has not been supplied.

The inventor alleges she made several attempts to determine the status of the application.

During April of 2004, more than 4 years after a petition under 37 CFR 1.137(b) was allegedly filed, the inventor spoke with Larry Schwartz of the PTO Customer Service Center. He informed the inventor the application was abandoned and sent a copy of the Notice of Abandonment to the inventor.

The instant petition was filed on March 28, 2005. The instant petition is accompanied by a power of attorney appointing David Hoffman as a legal representative. The power of attorney is signed with the name "Randi L. Black."

On April 22, 2005, the inventor filed a lawsuit against Kleinberg including allegations of malpractice. On May 16, 2005, Kleinberg filed a petition for access. On June 7, 2005, the Office informed applicant a petition for access had been filed and gave the inventor an opportunity to respond. Applicant filed an objection to the request for access on June 28, 2005.

A decision dismissing the petition for access was mailed July 15, 2005.

Discussion:

Attorney Hoffman was not an attorney of record at the time the application became abandoned. Attorney Hoffman was not in a position to have firsthand or direct knowledge of all the facts and circumstances of the delay. Nevertheless, the statement by Hoffman that the entire delay was unintentional is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay.¹ Therefore, the petition will be granted.

In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that a portion of the delay from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

The petition under 37 CFR 1.182

The application was filed September 14, 1998.

At the time the application was filed, the inventor's name was Randi L. Schindler.

The inventor married David Black on July 15, 2001.

The inventor's legal name is now Randi L. Black.

MPEP 605.04(c) states:

In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. . . . The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

The affidavit is not signed with both names - Randi L. Schindler and Randi L. Black.

As of November 1, 2004, the fee for petitions under 37 CFR 1.182 is \$400. Petitioner submitted \$130. Therefore, an additional \$270 must be submitted.²

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

¹ See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178; 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

² **Error! Main Document Only.** See Revision of Patent Fees for Fiscal Year 2005, 69 Fed. Reg. 52604 (Aug. 27, 2004) and Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, 1287 Off. Gaz. Pat. Office 67 (Oct. 12, 2004).

Further correspondence with respect to this matter should be addressed as follows:

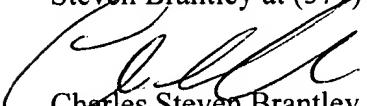
By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

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Alexandria, VA 22314

Once the petition under 37 CFR 1.182 is granted, the application will be forwarded to the examiner.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions